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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,398	08/28/2003	Elvin R. Lukenbach	JBP-5014	6758

27777 7590 10/29/2004

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EXAMINER	
MRUK, BRIAN P	
ART UNIT	**PAPER NUMBER**
1751	

DATE MAILED: 10/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/650,398	LUKENBACH ET AL.
	Examiner	Art Unit
	Brian P Mruk	1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 January 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *11/29/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The examiner construes the phrase "substantially free of amphoteric surfactants" recited in instant claims 1 and 9 to mean that the composition contains less than about 1% by weight of amphoteric surfactants, as defined by applicant on page 4, lines 29-31 of the instant specification.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 8, 10, and 12-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 8, 10 and 14 contain the trademarks/trade names "CARBOPOL AQUA SF-1". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods

associated with the trademark or trade name. In the present case, the trademarks/trade names are used to identify/describe a product and, accordingly, the identification/description is indefinite.

5. Instant claims 12 and 13 recite the phrase "The composition of claim". This phrase renders the claim vague and indefinite, since independent claim 11, from which claims 12 and 13 ultimately depend from, is a method claim. The examiner suggests that instant claims 12 and 13 should be amended to recite "The method of claim". Appropriate correction and/or clarification is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Shana'a et al, U.S. Patent No. 6,737,394.

Shana'a et al, U.S. Patent No. 6,737,394, discloses an isotropic cleansing composition for cleaning the human body (see abstract and col. 1, lines 7-10)

comprising surfactants, such as anionic surfactants (see col. 2, lines 7-10) and a thickening agent, such as hydrophobically modified, crosslinked polyacrylates (see col. 9, line 44-col. 10, line 21). Specifically, note Table 2, Example IV, which discloses a composition comprising 9% by weight of a blend of ammonium laureth sulfate/ammonium lauryl sulfate/cocamide MEA/PEG-5 cocamide, 0.8% by weight of cocamidopropyl betaine (i.e. which meets applicant's limitation of "substantially free of amphoteric surfactants, as outlined in paragraph no. 1 above), 0.5% by weight of glycerin, 1.5% by weight of CARBOPOL AQUA SF-1 (i.e. a hydrophobically modified, crosslinked polyacrylate compound), 0.1% by weight of polyquaternium-10, 1% by weight of organogel particles, and adjuncts to balance, per the requirements of the instant claims. Therefore, claims 1-14 are anticipated by Shana'a et al, U.S. Patent No. 6,737,394.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 10/650,226. Although the conflicting claims are not identical, they are not patentably distinct from each other because copending Application No. 10/650,226 claims a similar composition comprising an anionic surfactant, a hydrophobically modified, crosslinked, anionic acrylic copolymer, and, optionally, an amphoteric surfactant (see claims 1-18 of copending Application No. 10/650,226), as required by applicant in instant claims 1-14. Therefore, instant claims 1-14 are an obvious formulation in view of claims 1-18 of copending Application No. 10/650,226.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 1-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/650,573. Although the conflicting claims are not identical, they are not patentably distinct from each other because copending Application No. 10/650,573 claims a similar composition comprising an anionic surfactant, a hydrophobically modified, crosslinked, anionic acrylic copolymer, and about 1% by weight of an amphoteric surfactant (see claims 1-20 of copending Application No. 10/650,573), as required by applicant in instant claims 1-14. Therefore, instant claims 1-14 are an obvious formulation in view of claims 1-20 of copending Application No. 10/650,573.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claims 1-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 10/650,495. Although the conflicting claims are not identical, they are not patentably distinct from each other because copending Application No. 10/650,495 claims a similar composition comprising an anionic surfactant, a hydrophobically modified, crosslinked, anionic acrylic copolymer, optionally, about 1% by weight of an amphoteric surfactant, and about 1% by weight of a nonionic surfactant (see claims 1-17 of copending Application No. 10/650,495), as required by applicant in instant claims 1-14. Therefore, instant claims 1-14 are an obvious formulation in view of claims 1-17 of copending Application No. 10/650,495.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Mruk whose telephone number is (571) 272-1321. The examiner can normally be reached on Monday-Thursday from 7:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached on (571) 272-1316. The fax phone

number for the organization where this application or proceeding is assigned is (703) 872-9306.

BPM

Brian Mruk
October 27, 2004

Brian P. Mruk

Brian P. Mruk
Primary Examiner
Tech Center 1700